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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) E-80044 | | | | | | | | | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 10/763,027 | Filed January 21, 2004 | | | | | | | | | |
| | First Named Inventor Wolfgang Maus | | | | | | | | | | |
| | Art Unit 1795 | Examiner Matthew J. Merkling | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px; text-align: center;">/Alfred K Dassler/ _____ Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px; text-align: center;">Alfred K. Dassler _____ Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent of record. Registration number _____</td><td style="vertical-align: top; padding: 5px; text-align: center;">954-925-1100 _____ Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>52,794</u></td><td style="vertical-align: top; padding: 5px; text-align: center;">January 28, 2010 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | | <input type="checkbox"/> applicant/inventor. | /Alfred K Dassler/ _____ Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Alfred K. Dassler _____ Typed or printed name | <input type="checkbox"/> attorney or agent of record. Registration number _____ | 954-925-1100 _____ Telephone number | <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>52,794</u> | January 28, 2010 _____ Date |
| <input type="checkbox"/> applicant/inventor. | /Alfred K Dassler/ _____ Signature | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Alfred K. Dassler _____ Typed or printed name | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent of record. Registration number _____ | 954-925-1100 _____ Telephone number | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>52,794</u> | January 28, 2010 _____ Date | | | | | | | | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | | | | | | | | | |

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PRE-APPEAL BRIEF REQUEST FOR REVIEW
ARGUMENTS

Sir :

Please consider the following arguments pointing out the explicit errors of the Examiner:

As will be seen from the following remarks, in attempting to set forth that the claims are anticipated by Ota et al. (U.S. Patent No. 5,486,338) (hereinafter "Ota") and Maus et al. (U.S. Patent No. 5,916,530) (hereinafter "Maus"), the Examiner maintains an unreasonable position that is simply incorrect and unsupported.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 calls for, *inter alia*:

at least one contraction limiter configured for imparting an outwardly directed tensile stress in at least one part of the matrix for preventing the average initial diameter of the matrix from decreasing by more than 5% after repeated thermal alternating stresses in the range between 600°C and 1050°C.

Ota explicitly discloses to provide a cushion member (5) such "that thermal **expansion and contraction** of the honeycomb 3 is **not constrained by the case 2** but is **absorbed** by the cushion member 5 to prevent the honeycomb 3a from being damaged or broken by thermal distortion or **stress**" (column 4, lines 26 to 29).

The only way for the cushion member of Ota to be considered a contraction limiter, as recited in claim 1 of the instant application would be by in fact constraining expansion and contraction of the honeycomb to impart an outwardly directed stress as explicitly required by claim 1. However, this is explicitly the opposite of what Ota discloses with respect to the cushion member. Therefore, it is explicit that Ota does not disclose a contraction limiter, as required in claim 1 of the instant application.

On page 3 of the Office action the Examiner alleges that “the initial diameter ... therefore, the diameter does not decrease but rather stays the same.”

As seen from the second paragraph on page 3 of the specification of the instant application, the Examiner’s allegation is patently wrong. Specifically, the diameter of the matrix contracts beyond the initial diameter of the matrix, which results in the barrel shape of the matrix after repeated thermal stresses. Therefore, the Examiner’s allegation with respect to the diameter not decreasing, is patently wrong.

In a desperate attempt to support his position, on page 3 of the Office action the Examiner makes a conclusion with respect to an expansion of the diameter of the matrix of Ota based on calculations with respect to the matrix of Ota by referring to a material data sheet and the Stroom reference.

The Examiner’s conclusion is completely erroneous and invalid. Particularly, the Examiner provides a coefficient of expansion for the matrix body based on a grade of stainless steel suitable for decorative structural applications and not one that is suitable for exhaust system components. Furthermore, the Examiner does not show any calculations, merely a conclusion. Also, the Examiner relies on a diameter of a matrix of Stroom. However, it is absurd to rely on a diameter of a matrix, because the coefficient is a coefficient of linear expansion, which pertains to expansion per unit length. The diameter of the matrix is nowhere near the length of the foils wound to make the matrix. However any valid calculation can only begin with the length of the foils wound into the matrix, as it is the length of the foils themselves to which linear thermal expansion coefficients apply. Accordingly, the calculation and conclusion by the Examiner, with respect to the expansion/contraction of the diameter of the matrix of Ota are completely invalid.

On page 7 of the final Office action the Examiner alleges that with respect to Ota "the contraction limiters inherently exert an outward force on the honeycomb matrix."

As discussed in MPEP § 2112, a limitation recited in a claim that is not expressly or implicitly disclosed in a prior art reference is inherently disclosed therein if, and only if, the "missing" limitation is **necessarily present** in the prior art, and that it would be so **recognized by persons of ordinary skill**. The principles of inherency require that the inherency be **absolute**, and not probabilistic. As far as appellant was able to ascertain, there is no disclosure or suggestion in Ota that it is **absolutely necessary** that the cushion members inherently exert an outward tensile force on the matrix as required by claim 1 of the instant application.

Furthermore, according to a sub-heading in MPEP § 2112, the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", i.e. the Examiner has the burden of proof (by a preponderance of the evidence) to show that Ota **necessarily** disclose or suggest purposefully that the cushion members inherently exert an outward force on the matrix. Instead of offering factual evidence disclosing or suggesting the cushion member exert an outwardly directed tensile force, in the context of the present invention, the Examiner made a statement without any factual support or *Official Notice*. The Examiner cannot simply be the devil's advocate postulating certain results or processes that may or may not occur or be present in the applied prior art and leave it up to appellant to show or prove the contrary.

Accordingly, the Examiner has not met the requirements of MPEP 2112 for inherency. Therefore, the Examiner's allegations based on inherency of Ota, are patently wrong.

As seen from the above-given remarks, Ota does not show at least one contraction limiter configured for imparting an outwardly directed tensile stress in at least one part of the matrix for preventing the average initial diameter of the matrix from decreasing by more than 5% after repeated thermal alternating stresses in the range between 600°C and 1050°C, as recited in claim 1 of the instant application.

Although not stated, it is believed that based on the Examiner's remarks in item 3, the Examiner is also rejecting claim 1 as being anticipated by Maus. Accordingly, the following remarks pertain to an anticipation rejection of claim 1 over Maus.

On page 6 of the Office action the Examiner alleges that Maus discloses "at least one contraction limiter... (the limiter will inherently provide a stress to the matrix since it is attached, see col. 5, lines 5-8) for preventing the average initial diameter of said matrix from decreasing by more than 5% after repeated alternating thermal stresses in the range between 600C and 1050C."

The Examiner does not meet the requirements of MPEP 2112 related to inherency.

Particularly, as far as appellant was able to ascertain, there is no disclosure or suggestion in *Maus* that it is ***absolutely necessary*** that the connecting tube inherently exerts an outwardly directed tensile force on the matrix, as required in claim 1 of the instant application.

Furthermore, according to a sub-heading in MPEP § 2112, the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", i.e. the Examiner has the burden of proof (by a preponderance of the evidence) to show that *Maus* ***necessarily*** disclose or suggest purposefully that the connecting tube inherently exert an outwardly directed tensile force on the matrix, as required in claim 1 of the instant application. Instead of offering factual evidence disclosing or

suggesting the connecting tube exert an outward force, in the context of the present invention, the Examiner made a statement without any factual support or *Official Notice*. The Examiner cannot simply be the devil's advocate postulating certain results or processes that may or may not occur or be present in the applied prior art and leave it up to appellant to show or prove the contrary.

With respect to Maus, the Examiner has not met the requirements of MPEP 2112 for inherency. Therefore, the Examiner's allegations based on inherency with respect to Maus are patently wrong.

As seen from the above-given remarks, Maus does not show at least one contraction limiter configured for imparting an outwardly directed tensile stress in at least one part of the matrix for preventing the average initial diameter of the matrix from decreasing by more than 5% after repeated thermal alternating stresses in the range between 600°C and 1050°C, as recited in claim 1 of the instant application.

Applicant asserts that the arguments provided above are sufficient to show the explicit errors of the Examiner, and applicant requests that the Panel overturn the Examiner's rejection because of the explicit errors.

Respectfully submitted,

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AKD:cgm

January 28, 2010
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